IN THE UNITED STATES PATENT & TRADEMARK OFFICE

In re the Application of:	)	**MAIL STOP AF**
	)	
Syed, Majid	)	
	)	Group Art Unit: 2155
Serial No.: 10/044,195	)	
	)	Examiner: Nguyen, Thuong
Filed: October 26, 2001	)	
	)	
For: Arbitrator System and Method for National and Local Content Distribution	)	Conf. No.: 9765

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL-BRIEF REQUEST FOR REVIEW

Sir:

Claims 1-38 stand finally rejected. In particular, Claims 1, 5, 8-9, 11, 13-19, 23, 26-27, 29 and 31-36 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Application Pub. No. 2002/0095228 of Corts et al. (hereinafter "Corts"). Claims 2 and 20 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Corts in view of U.S. Pat. No. 5,935,218 to Beyda et al. (hereinafter "Beyda"). Claims 3-4, 7, 10, 21-22, 25 and 28 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Corts in view of U.S. Application Pub. No. 2002/0044567 to Voit et al. (hereinafter "Voit"). Claims 6 and 24 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Corts in view of U.S. Pat. No. 5,615,249 to Solondz et al. (hereinafter "Solondz"). Claims 12 and 30 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Corts in view of U.S. Pat. No. 6,782,510 to Gross et al. (hereinafter "Gross").

The rejections of claims 1-38 are now appealed. Review of the final rejection prior to filing an appeal brief is respectfully requested for the reasons set forth below. It is respectfully submitted that the rejections fail to establish *prima facie* cases of anticipation and obviousness and are based upon clear errors of fact and law.

I. Corts Does Not Disclose the Combination of Features Recited in Independent Claims 1, 19, 37 and 38

The rejection of claims 1, 19, 37 and 38 does not make out a *prima facie* case of anticipation because Corts does not disclose the combination of features recited in these claims. Independent claim 1 recites an intelligent digital broadcast scheduling system. The system comprises a messaging protocol, which comprises at least priority indicators, service categories, and service classes. The system also comprises an arbitrator, the arbitrator intelligently determining a relative value of specified priority indicators, service categories, and service classes of data content entities from a group of requesting content providers. The system also comprises a scheduler, the scheduler collecting and sequencing the data content for broadcast based on the arbitrator determinations. The system further comprises an in-band on-channel (IBOC) network broadcasting said data content as per said sequence. Claim 19 recites the above noted subject matter as well as additional subject matter. Claims 37 and 38 recite different combinations, each of which requires, *inter alia*, determining a relative value of specified priority indicators, service categories and service classes of a messaging protocol for the data content. Corts does not disclose the combinations of features in these claims as discussed below.

A. Corts Does Not Disclose Priority Indicators of a Messaging Protocol as recited in Independent Claims 1, 19, 37 and 38.

Corts does not disclose a messaging protocol including priority indicators as recited in claims 1, 19, 37 and 38. As noted in the specification at paragraphs 0040-0045, priority indicators indicate transmission priority and can include, for example, extreme high priority (e.g., suspend current transmission, useful in emergency alert situations), high priority (e.g., transmission occurs at the earliest opportunity), normal (e.g., transmission according to the associated repetition rate) and background/low (e.g., the minimum broadcast requirement is defined by the repetition rate). Applicant's previous Amendment pointed out (page 11) that the scheduling and timing parameters disclosed at paragraphs 0233-0239 of Corts (e.g., "the time at which the datacast element will be broadcast," "the length of time it will be broadcast," "the frequency with which it will be broadcast" and "the starting and ending dates for the above parameters") do not constitute the claimed priority indicators.

In response to Applicant's arguments, the Final Office Action further states:

> Corts discloses that the method of inserting the schedule parameters, broadcast rules, timing, level of data, acceptance level of service . . . which would be characterized accordingly to the presentation elements. Therefore, the priority indicator could be one of the criteria accordingly to the presentation data as requested from the message. (Final Office Action at p. 22).

Applicant is unable to understand the Office's statement above and respectfully submits that the Office's statement, whatever it may mean, does not demonstrate that Corts discloses the claimed priority indicators. Is the Office saying that "criteria [according] to the presentation data" could be the claimed priority indicators? Is the Office saying that "presentation elements" include schedule parameters, broadcast rules, timing, level of data, acceptance (understood to mean "acceptable") level of service? What are the "criteria [according] to the presentation data," and how does that criteria allegedly indicate transmission priority? Nevertheless, one thing is clear from the Office's statement: the Office's use of the words "could be" in its statement "the priority indicator could be one of the criteria . . ." demonstrates that Corts does not disclose priority indicators as claimed. Rather, the Office is seeking to interpret Corts according to what "could be."

There is simply no disclosure in Corts whatsoever of a messaging protocol that comprises priority indicators (i.e., indicators that indicate transmission priority). The rejection is flawed for at least this reason and should be withdrawn.

B. Corts does not Inherently Disclose the Claimed Priority Indicators

As noted above, the Final Office Action states at page 22, "the priority indicator could be one of the criteria accordingly to the presentation data as requested from the message." (Emphasis added). If this language is intended to suggest that Corts somehow inherently discloses the claimed priority indicators, it is respectfully submitted that the Office is applying the wrong standard for inherency. As noted at MPEP § 2112, "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex Parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App & Inter. 1990) (emphasis original.) "Inherency, however, may not be established by probabilities and possibilities. The mere fact that a certain thing may result

from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

Under the correct standard for inherency, there is no inherent disclosure in Corts of the claimed priority indicators. The Office's use of the language "could be" reflects that whatever "criteria" the Office is referring to, that criteria does not necessarily constitute subject matter that corresponds to the claimed priority indicators. Thus, Corts does not anticipate claims 1, 19, 37 and 38 under a theory of inherency.

C. Corts Does Not Disclose Service Classes of a Messaging Protocol as recited in Independent Claims 1, 19, 37 and 38, and the Office did not Respond to Applicant's Arguments in this Regard

Corts does not disclose a messaging protocol including service classes as recited in claims 1, 19, 37 and 38. As noted in the present application at paragraph 0046, service classes relate to grades of service, e.g., that can be requested by a content provider, and which can include, for example, basic, preferred, premium, etc. At page 11 of the Amendment of January 17, 2006, Applicant explained why paragraph 0218 of Corts does not disclose a messaging protocol comprising service classes as claimed. Namely, paragraph 0218 of Corts relates to monitoring available bandwidth to determine the quantity of data that can be added to audio to achieve an "acceptable level of service." The reference in Corts to an "acceptable level of service," however, in no way constitutes a disclosure of service classes, such as, for example, basic, preferred, premium, etc. The Office is clearly misreading Corts in this regard. The rejection is flawed for at least this additional reason and should be withdrawn.

Moreover, the "Response to Arguments" at pp. 22-23 of the Final Office Action did not respond to Applicant's arguments in this regard. This is improper. As noted at M.P.E.P. § 707.07(f), "Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." Further, as stated in MPEP § 706.07, "The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal." The Office has clearly not done so in this instance.

II. Dependent Claims 2-18 and 20-36 are Allowable at Least by Virtue of Dependency, and Beyda does not Disclose the Subject Matter of Claims 2 and 20

Claims 2-18 and 20-36 have been rejected as allegedly obvious over Corts in view of various secondary references as noted at page 1 of this paper. These claims depend variously from claims 1 and 19 and are, therefore, allowable at least by virtue of dependency. Withdrawal of the rejections against these claims should, therefore, be withdrawn.

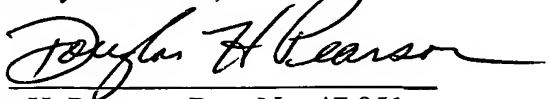
In addition, contrary to the Office's contention, the subject matter recited in dependent claims 2 and 20 is not disclosed in Beyda. Claims 2 and 20 recite that the system comprises a hierarchy of gateways, one or more first level gateways arbitrating and scheduling a first data content level and one or more second level gateways operatively connected to said first level gateway(s) and arbitrating and scheduling a second data content level. In response to Applicant's arguments in the previous Amendment, the Office Action at p. 22 states that Beyda discloses categorizing the priority of users so that low priority users must wait a specific amount of time while high priority users are able to use data as soon as possible. The Final Office Action also cites to Beyda's Abstract and col. 3, lines 4-10, 13-18 and 28-32 in this regard. (Final Office Action at pp. 11-13.) Applicant respectfully submits that the Office is misreading claims 2 and 20. Claims 2 and 20 do not recite subject matter regarding how to treat low priority and high priority users; rather, these claims recite that the claimed system comprises a hierarchy of gateways, namely, one or more first level gateways and one or more second level gateways operatively connected to said first level gateway(s). Users are not gateways. The rejection is clearly flawed and should be withdrawn.

III. Conclusion

As explained above, the rejections in the Final Office Action do not establish *prima facie* cases of anticipation and obviousness and are based upon clear errors of fact and law. For at least the reasons given above, it is respectfully requested that the rejections be withdrawn and that a Notice of Allowance be issued.

Respectfully submitted,

Date: August 22, 2006

By: 

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